

DOCKET NO: 210039US2



IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :

HIROSHI SHINGAI, ET AL. :

EXAMINER: ORITZ CRIADO, JORGE L.

SERIAL NO: 09/883,199 :

FILED: JUNE 19, 2001 :

GROUP ART UNIT: 2655

FOR: OPTICAL RECORDING MEDIUM :  
AND OPTICAL RECORDING METHOD

**DECLARATION UNDER 37 C.F.R. § 1.131**

We, the undersigned, hereby declare that:

1. On October 10, 2003 we received a letter from our U.S. attorney inquiring about (i) the need to correct inventorship of U.S. Patent No. 6,169,722 (with named inventors Mr. Takashi Kikukawa and Mr. Hajime Utsunomiya, hereinafter the '722 patent), of U.S. Application Serial No. 09/883,199 (hereinafter the '199 application), or of both; and (ii) whether or not it would be possible that Mr. Hajime Utsunomiya was the sole inventor of the commonly disclosed subject matter.
2. On January 29, 2004, we replied to our U.S. attorney's inquiry by stating that (i) the invention in the '199 application was an improvement over the invention recited in the '722 patent, as described on page 17, lines 13-18 of the '199 application; (ii) Claim 1 was to be amended to recite the exclusion of Ag; and (iii) Mr. Takashi Kikukawa, who was a joint inventor of the '722 patent, also contributed to the invention of the '199 application and, as such, the inventorship of the '199 application should be corrected. In this communication, although it was our knowledge that Mr. Hiroshi Shingai, Mr. Hiroyasu Inoue, Mr. Tatsuya Kato, Mr. Hajime Utsunomiya, and Mr. Takashi Kikukawa had invented the commonly disclosed subject matter, i.e., the subject matter of the comparative examples described in col. 3, lines 29-48 and col. 13, lines 6-13 of the '722 patent, we fail to adequately explain this fact.
3. In reply, on February 18, 2004, our U.S. attorney prepared a draft response to the outstanding office action for our review that included: (i) drafts of all needed documents to change inventorship of the '199 application to include Mr. Takashi Kikukawa; and (ii) a draft of a declaration under 37 C.F.R. § 1.131 stating that Mr. Takashi Kikukawa and Mr. Hajime Utsunomiya were named inventors in the '199 application and in the '722 patent and invented the subject matter disclosed in the '722 patent that is common to the '199 application. We signed the draft of the declaration under 37 C.F.R. § 1.131 based on the expertise of the U.S. attorneys, without recognizing that it reflected an erroneous statement of inventorship. We therefore signed it without any deceptive intention. This declaration was filed on February 26, 2004.

4. We have now come to recognize that the declaration under 37 C.F.R. § 1.131 included an incorrect statement of the inventorship.

5. Since we now understand that the declaration under 37 C.F.R. § 1.131 filed on February 26, 2004 was incorrect, for the reasons explained above, but made in good faith and without any intent to deceive, we further declare the following:

- (a) The invention claimed in the '722 patent, i.e., a recording layer with Ag, In, Sb, and Te, was invented by Mr. Takashi Kikukawa and Mr. Hajime Utsunomiya;
- (b) The invention described in the comparative examples of the '722 patent, i.e., a recording layer with Ge, Sb, Te, and without Ag, was invented by Mr. Hiroshi Shingai, Mr. Hiroyasu Inoue, Mr. Tatsuya Kato, Mr. Hajime Utsunomiya, and Mr. Takashi Kikukawa;
- (c) The invention recited in the claims of the '199 application before the Amendment filed on February 26, 2004, i.e., a recording layer with Sb as a main component, was invented by Mr. Hiroshi Shingai, Mr. Hiroyasu Inoue, Mr. Tatsuya Kato, Mr. Hajime Utsunomiya, and Mr. Takashi Kikukawa;
- (d) The invention recited in the claims of the '199 application after the amendment filed on February 26, 2004, i.e., a recording layer with Sb as a main component, but without Ag, was invented by Mr. Hiroshi Shingai, Mr. Hiroyasu Inoue, Mr. Tatsuya Kato, Mr. Hajime Utsunomiya, and Mr. Takashi Kikukawa;
- (e) The subject matter of the comparative examples described in col. 3, lines 29-48 and col. 13, lines 6-13 of the '722 patent was made first, compared to the invention claimed in the '722 patent, was thereafter described in the '722 patent, and was later filed in the '199 application;
- (f) We further declare that all statements made herein of our knowledge are true and that all statements on information and belief are believed to be true; and further that these statements were made with knowledge that willful false statements and the like so made are punishable by a fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Hiroshi Shingai  
Signature of Hiroshi SHINGAI

April 25, 2005  
Date signed

Hiroyasu Inoue  
Signature of Hiroyasu INOUE

April 25, 2005  
Date signed

Tatsuya Kato  
Signature of Tatsuya KATO

April 25, 2005  
Date signed

Hajime Utsunomiya  
Signature of Hajime UTSUNOMIYA

April 25, 2005  
Date signed

Takashi Kikukawa  
Signature of Takashi KIKUKAWA

April 25, 2005  
Date signed